

United States Patent and Trademark Office



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

PPLICATION NO.		FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,192		03/02/2004	Todd O. Bolken	4794.4US (01-0185.04/US)	1966
24247	7590	08/08/2006	EXAMINER		NER
TRASK BRITT			ZARNEKE. DAVID A		
P.O. BOX 2550 SALT LAKE CITY, UT 84110		UT 84110		ART UNIT	PAPER NUMBER
				2891	
				DATE MAILED: 08/08/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

		Applicati	on No.	Applicant(s)		
		10/791,19	92	BOLKEN, TODD O.		
	Office Action Summary	Examine		Art Unit		
		David A. Z	Zarneke	2891		
Period fo	The MAILING DATE of this communic			h the correspondence a	ddress	
	• •	D DEDLY 10 OFT T	O EVDIDE A MO	NTUO OR TURETY (20\ DA\(C	
WHIC - Exter after - If NO - Failu Any	ORTENED STATUTORY PERIOD FOR CHEVER IS LONGER, FROM THE MAINS IN THE M	ILING DATE OF TH 37 CFR 1.136(a). In no evication. tory period will apply and w II, by statute, cause the app	HIS COMMUNIC ent, however, may a re- ill expire SIX (6) MONT dication to become ABA	ATION. bly be timely filed HS from the mailing date of this NDONED (35 U.S.C. § 133).		
Status						
1)⊠	Responsive to communication(s) filed	on 19 May 2006.				
	• •)⊠ This action is n	ion-final.			
3)[Since this application is in condition fo	r allowance except	for formal matte	rs, prosecution as to th	e merits is	
	closed in accordance with the practice	e under <i>Ex parte Qu</i>	<i>ayle</i> , 1935 C.D.	11, 453 O.G. 213.		
Dispositi	on of Claims					
4)⊠	Claim(s) 1-17 is/are pending in the ap	plication.				
	4a) Of the above claim(s) is/are withdrawn from consideration.					
	Claim(s) is/are allowed.					
6)⊠	Claim(s) 1-17 is/are rejected.					
7)	Claim(s) is/are objected to.					
8)[Claim(s) are subject to restriction	on and/or election r	equirement.			
Applicati	on Papers					
9)	The specification is objected to by the	Examiner.				
	The drawing(s) filed on is/are: a		objected to b	y the Examiner.		
	Applicant may not request that any objection	on to the drawing(s) t	oe held in abeyand	e. See 37 CFR 1.85(a).		
	Replacement drawing sheet(s) including the	ne correction is requir	ed if the drawing(s	s) is objected to. See 37 C	FR 1.121(d).	
11)	The oath or declaration is objected to b	by the Examiner. No	ote the attached	Office Action or form P	TO-152.	
Priority ι	ınder 35 U.S.C. § 119					
	Acknowledgment is made of a claim fo ☐ All b) ☐ Some * c) ☐ None of:	r foreign priority un	der 35 U.S.C. §	119(a)-(d) or (f).		
	1. Certified copies of the priority documents have been received.					
	2. Certified copies of the priority documents have been received in Application No					
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.						
	bee the attached detailed Office action	for a list of the cert	med copies not r	eceivea.		
Attachmen	t(s) e of References Cited (PTO-892)		4)	mman/(DTO 442)		
	e of References Cited (P10-892) e of Draftsperson's Patent Drawing Review (PT0	D-948)	Paper No(s)	ımmary (PTO-413) /Mail Date		
3) 🔲 Infor	mation Disclosure Statement(s) (PTO-1449 or PT r No(s)/Mail Date		5) Notice of Inf 6) Other:	omal Patent Application (PT 	ГО-152)	

Page 2

DETAILED ACTION

Response to Arguments

It is agued that the factual basis for the double patenting rejection were not set forth in the previous office action. These will be detailed below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In *re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,730,995 and claims 1, 3, 4, 5, 9, 12, 13, 16-18, 20, 22, 23, 29, 30, 33, and 34 of US Patent 6,538,311.

Page 3

Although the conflicting independent claims are not identical, they are not patentably distinct from each other because:

- 1) the patents recites "printed circuit substrate" while the application recites "substrate". The application is broader than the patents, therefore it reads upon the same component.
- 2) the patents recites a 'circuit side" and a "back side" while the application recites a "first side" and a "second side". The application is broader than the patents, therefore it reads upon the same components.
- 3) the patents recite "a peripheral substrate edge joining the back side to the circuit side, while the application is silent regarding this. Again, the application is broader than the patents, therefore it reads upon the same components.
- 4) the patents merely uses different language to say the same thing with regard to the "first plastic molding", which equates to the "encapsulated semiconductor component" of the application, and the "second plastic molding", which equates to the "molded peripheral portion".

the remaining claims correspond as follows:

Application	6,730,995	6,538,311
2	2, 11	3
3	3, 12	5
4	4	6
5	5, 13	9
6	6, 14	12

Application/Control Number: 10/791,192 Page 4

Art Unit: 2891

7	7, 15	13
8	8, 16	16
9	9, 17	17
10	10	18
11	11, 2	20
12	12, 3	22
13	4	23
14	14, 6	29
15	15, 7	30
16	16, 8	33
17	17, 9	34

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Zarneke whose telephone number is (571)-272-1937. The examiner can normally be reached on M-Th 7:30 AM-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Baumeister can be reached on (571)-272-1722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number: 10/791,192

Art Unit: 2891

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Page 5

David A. Zarneke Primary Examiner

July 26, 2006